Question Q217

National Group: **ESTONIA**

Title: **The patentability criterion of inventive step / non-obviousness**

Contributors: **Prof. Ants KUKRUS and Raul KARTUS**

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Questions

I. Analysis of current law and case law

The Groups are invited to answer the following questions under their national laws:

Level of inventive step / non-obviousness

1. What is the standard for inventive step / non-obviousness in your jurisdiction? How is it defined?

   An invention shall be considered as involving an inventive step if, having regard to the state of the art, it is not obvious to a person skilled in the art.

2. Has the standard changed in the last 20 years? Has the standard evolved with the technical / industrial evolution of your jurisdiction?
   The standard has not changed.

3. Does your patent-granting authority publish examination guidelines on inventive step / non-obviousness? If yes, how useful and effective are the guidelines?
   No

4. Does the standard for inventive step / non-obviousness differ during examination versus during litigation or invalidity proceedings?
   No

Construction of claims and interpretation of prior art

5. How are the claims construed in your jurisdiction? Are they read literally, or as would be understood by a person skilled in the art?
   The claims are to be understood as that defined by the strict, literal meaning of the wording.

6. Is it possible to read embodiments from the body of the specification into the claims?
   No

7. How is the prior art interpreted? Is it read literally or interpreted as would be understood by a person skilled in the art? Is reliance on inherent disclosures (aspects of the prior art that are not explicitly mentioned but would be understood to be present by a person skilled in the art) permitted?
   The prior art is interpreted as would be understood by a person skilled in the art.

8. Do the answers to any of the questions above differ during examination versus during litigation?
   No

Combination or modification of prior art

9. Is it proper in your jurisdiction to find lack of inventive step or obviousness over a single prior art reference? If yes, and assuming the claim is novel over the prior art reference, what is required to provide the missing teaching(s)? Is argument sufficient? Is the level of the common general knowledge an issue to be considered?
   Yes. A claimed invention cannot be considered to involve an inventive step where a document is such that when taken alone may be considered as involving common general knowledge of the person skilled in the art.

10. What is required to combine two or more prior art references? Is an explicit teaching or motivation to combine required?
    Teaching or suggestion does not need to be explicit. (Could-would approach.)

    It means that the question to be answered is there any teaching in the prior art as a whole that would, not simply could, have prompted the skilled person, faced with the objective technical problem, to modify or adapt the closest prior art while taking account of that teaching, thereby arriving at something falling within the terms of the claims, and thus achieving what the invention achieves?

11. When two or more prior art references are combined, how relevant is the closeness of the technical field to what is being claimed? How relevant is the problem the inventor of the claim in question was trying to solve?
    The combining of two or more parts prior art references would be obvious if there is a reasonable basis for the skilled person to associate these parts with one another. He may be expected to look for suggestions in neighbouring and general technical fields.

12. Is it permitted in your jurisdiction to combine more than two references to show lack of inventive step or obviousness? Is the standard different from when only two references are combined?
    Generally no more than two references shall be combined to show lack of inventive step.

13. Do the answers to any of the questions above differ during examination versus during litigation?

No

Technical Problem

14. What role, if any, does the technical problem to be solved play in determining inventive step or non-obviousness?

In order to assess inventive step so-called "problem-and-solution approach" applied. The technical problem means the aim and task of modifying or adapting the closest prior art to provide the technical effects that the invention provides over the closest prior art.

15. To what degree, if any, must the technical problem be disclosed or identified in the specification?

The technical problem may not be what the applicant presented as "the problem" in his application and may require reformulation, since the objective technical problem is based on objectively established facts, in particular appearing in the prior art revealed in the course of the proceedings.

Advantageous effects

16. What role, if any, do advantageous effects play in determining inventive step or non-obviousness?

Any effect provided by the invention may be used as a basis for the reformulation of the technical problem, as long as said effect is derivable from the application.

17. Must the advantageous effects be disclosed in the as-filed specification?

Any advantageous effects of the invention with reference to the background art must be disclosed in the as-filed specification.

18. Is it possible to have later-submitted data considered by the Examiner?

Yes. It is also possible to rely on new effects submitted subsequently during the proceedings by the applicant.

19. How “real” must the advantageous effects be? Are paper or hypothetical examples sufficient?

Paper examples are required, however, hypothetical examples are also accepted as the case may be.

20. Do the answers to any of the questions above differ during examination versus during litigation?

No.

Teaching away

21. Does your jurisdiction recognize teaching away as a factor in favour of inventive step / non-obviousness? Must the teaching be explicit?

No.

22. Among the other factors supporting inventive step / non-obviousness, how important is teaching away?
23. Is there any difference in how teaching away is applied during examination versus in litigation?

No.

Secondary considerations

24. Are secondary considerations recognized in your jurisdiction?
    No.
25. If yes, what are the accepted secondary considerations? How and to what degree must they be proven? Is a close connection between the *claimed* invention and the secondary considerations required?
26. Do the answers to any of the questions above differ during examination versus during litigation?
    No.

Other considerations

27. In addition to the subjects discussed in questions 4 - 26 above, are there other issues, tests, or factors that are taken into consideration in determining inventive step / non-obviousness in your jurisdiction?
    No.

    If yes, please describe these issues, tests, or factors.

Test

28. What is the specific statement of the test for inventive step/non-obviousness in your jurisdiction? Is there jurisprudence or other authoritative literature interpreting the meaning of such test and, if so, provide a brief summary of such interpretation.
    Invention, having regard to the state of the art, must not be obvious to a person skilled in the art. In order to decide whether an invention involves an inventive step a "problem-solution approach" applies.

29. Does such test differ during examination versus during litigation?
    No.

Patent granting authorities versus courts

30. If there are areas not already described above where the approach to inventive step / non-obviousness taken during examination diverges from that taken by courts, please describe these areas.
    No. The number of patent cases in Estonian courts is low.

31. Is divergence in approach to inventive step / non-obviousness between the courts and the patent granting authority in your jurisdiction problematic?
    No.

Regional and national patent granting authorities

32. If you have two patent granting authorities covering your jurisdiction, do they diverge in their approach to inventive step / non-obviousness?
    No. The Estonian Patent Office uses the same "problem-solution approach" to inventive step as the European Patent Office (EPO).
33. If yes, is this problematic?

II. Proposals for harmonization

The Groups are invited to put forward proposals for the adoption of harmonised rules in relation to the patentability criteria for inventive step / non-obviousness. More specifically, the Groups are invited to answer the following questions without regard to their national laws:

34. Is harmonization of inventive step / non-obviousness desirable?
Yes.

35. Is it possible to find a standard for inventive step / non-obviousness that would be universally acceptable?

36. Please propose a definition for inventive step / non-obviousness that you would consider to be broadly acceptable.

37. Please propose an approach to the application of this definition that could be used by examiners and by courts in determining inventive step / non-obviousness.
The "problem-solution approach" would be the preferred method.

SUMMARY

An invention shall be considered as involving an inventive step if, having regard to the state of the art, it is not obvious to a person skilled in the art. In the last 20 years the standard has not changed. The claims are to be understood as that defined by the strict, literal meaning of the wording. The prior art interpreted as would be understood by a person skilled in the art. In order to assess inventive step so-called “problem-and-solution approach” applied. Therefore, our jurisdiction does not recognize secondary considerations and teaching away as a factor in favour of inventive step. The "problem-solution approach" would be the preferred method for determining inventive step by examiners and by courts.

RÉSUMÉ

Une invention sera considérée impliquée au critére inventif, si cette invention n’est pas évidente pour un homme du métier considérant l’état de la technique. Les derniers 20 ans le standard n’a pas changé. La revendication doit etre interprétée strictement dans le sens propre de la formulation. Le niveau technique interpété comme par l’homme du métier. Pour évaluer le critére inventif on utilise l’approche de type „probléme et solution“. Par coséquant, notre jurisdiction ne reconnait ni „secondary considerations“, ni „teaching away“ comme des facteurs en faveur du critére inventif. La méthode préférée pour les experts et les tribunaux pour déterminer le critére inventif serait l’approche de type „probléme et solution“.

ZUSAMMENFASSUNG

Eine Erfindung wird als ein erfinderischer Schritt berücksichtigt, wenn es für einen Fachmann angesichts des technischen Niveaus nicht offensichtlich ist. In den letzten 20 Jahren hat sich der Erfindungsmaßstab nicht geändert. Patentansprüche sind als die von der strengen wörtlichen Bedeutung des Wortlauts zu verstehen. Der Stand der Technik wird interpretiert wie es von einem gelehrten Fachmann in der Technik verstanden wird. Um einen erfinderischen Schritt zu bewerten, wird ein so genannter " Problem-Lösungsansatz " verwendet. Daher werden “secondary considerations“ und „ teaching away“ by unserer Gerichtsbarkeit als Faktor zugunsten der erfinderischen Tätigkeit nicht anerkannt. Der "Problem-Lösungsansatz" wäre die bevorzugte Methode für die Bestimmung der Erfindungshöhe durch Prüfer und für Gerichte.